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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/680,346

10/07/2003

Harald Walter

PF/5-31300B/D1

5652

26748

7590

09/06/2005

EXAMINER

GRAZIER, NYEEMAH

SYNGENTA CROP PROTECTION, INC.
PATENT AND TRADEMARK DEPARTMENT
410 SWING ROAD
GREENSBORO, NC 27409

ART UNIT

PAPER NUMBER

1626

DATE MAILED: 09/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/680,346

Applicant(s)

WALTER ET AL.

Examiner

Nyeemah Grazier

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,5,6,10,11 and 13 is/are pending in the application.
- 4a) Of the above claim(s) 1, 2, 5 and 6 (in part) and 10,11 and 13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 10/181,702.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/20/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

I. ACTION SUMMARY

Claims 3, 4, 7-9, 12 and 14 have been cancelled. Claims 1, 2, 5, 6, 10, 11 and 13 are pending. Claims 1, 2, 5, and 6, in part, and 10, 11 and 13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected subject matter and or species.

II. PRIORITY

This application is a Divisional of U.S. Application Serial No. 10/181,702, now U.S. Patent No. U.S. 6,806,286, which is a National Stage Application under 35 U.S.C. 371 for EPO PCT/EP01/00592, filed January 19, 2001. This application claims the benefit to foreign application UK 0001447.2 filed on January 21, 2000.

III. RESPONSE TO RESTRICTION/ELECTION

Applicant's election without traverse of Group III, claims 1-9 in the reply filed on August 12, 2005 is acknowledged.

IV. ELECTION

Status of the Claims

Applicant's provisional election without traverse of the compound 2.23 as shown in table 2, in response to the requirement to restrict the products of Formula (I) is acknowledged.

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Therefore, the scope of the invention for the elected subject matter are Claims 1, 2, 5, 6 as recited in "Amendments to the Claims" in the Response filed August 12, 2005 wherein:

X is oxygen;

R₁-R₅ are as defined in the amended claims;

A is A₂, A₃ and A₄.

V. REJECTIONS

A. Obviousness-Type Double Patenting

Claims 1, 2, 5 and 6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 of Eberle et al. (US Patent No. 6,365,620).

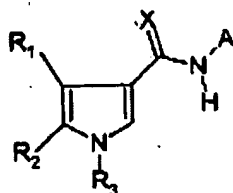
A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). See also M.P.E.P. § 804 (2001).

Obvious-type nonstatutory double patenting rejection is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. §103" with the distinction that the double patent rejection is not considered prior art. *Id.* See also *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Thus, the analysis employed in an obviousness-type double patent rejection is

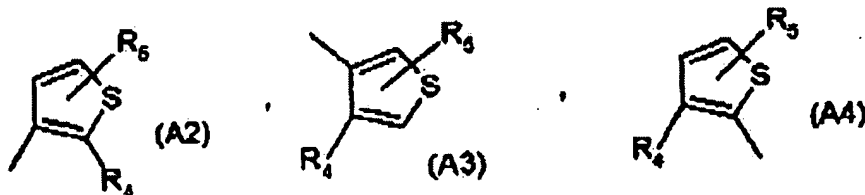
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consistent with a §103(a) analysis set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966).

Although the conflicting claims are not identical, they are not patentably distinct from each other. First, **Instant Claims 1, 2, 5 and 6** are drawn to compounds of Formula (I),



wherein A is a group selected from A₂, A₃ or A₄

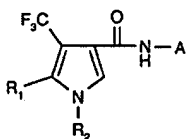


wherein: X is oxygen, **R₁** is substituted or unsubstituted C₁-C₄ alkyl, with the exception of CF₃; substituted or unsubstituted C₃-C₆ cycloalkyl; or halogen; **R₂** is hydrogen, substituted or unsubstituted C₁-C₄ alkyl; substituted or unsubstituted C₁-C₄ alkoxy; cyano or halogen; **R₃** is substituted or unsubstituted C₁-C₄ alkyl; **R₄** *inter alia* represents C₃-C₇ cycloalkyl, unsubstituted phenyl and substituted phenyl; **R₅** represents hydrogen, halogen, and C₁-C₄ haloalkyl. (See Amend. to the Claims, pp. 2-5).

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Determining the Scope and Contents of the Co-pending Application

Conflicting claims 1-7 of U.S. Patent No. 6,356,620 B2, Eberie et al, recites a compound of formula (I). (See col. 22, ll. 16-62).



R₁ is hydrogen, substituted or unsubstituted C₁-C₄ alkyl, C₁-C₄ haloalkyl or halogen (See col. 22, l, 29);

R₂ represents substituted or unsubstituted C₁-C₄ alkyl (See col. 22, ll. 30-33);

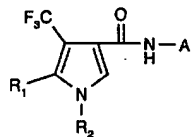
A is an orthosubstituted thienyl wherein the substituent is R₄ (See col. 22, ll. 34-43);

R₃ is C₃-C₇ cycloalkyl, unsubstituted phenyl and substituted phenyl (See col. 22, ll. 46-59);

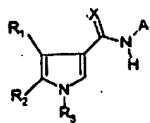
R₄ is hydrogen, hydrogen, halogen, and C₁-C₄ haloalkyl, C₁-C₄ haloalkoxy, C₁-C₄ alkyl, and C₁-C₄ haloalkyl alkoxy (See col. 22, ll. 60-62).

Ascertaining the Differences Between Eberie et al. and the Instant Claims

The difference between the instant claims and Eberie et al. is that the compound of formula (I) is drawn to a subgenus wherein the formula is drawn to trifluorocarbon pyrrolicarboxamide.



Contrarily, the Instant application is drawn to pyrrolicarboxamide wherein the pyrrole may be substituted (R1) with substituted C₁-C₄ alkyl groups, except CF₃.



Resolving the Level of Ordinary Skill in the Pertinent Art

Absent a showing of unexpected results, it would have been obvious to one of ordinary skill in the art to synthesize the compound of the conflicting claims in Eberie et al.

A person skill in the pertinent art would be motivated to prepare the compounds of the instant invention by replacing the CF₃ for other halo substituted alkyls such as CBr₃, CCl₃ or CI₃ because fluorine, chlorine, bromine and iodine are all halogens and all classified in Group VII of the periodic table and therefore have similar properties. See e.g. Ex parte Wiseman, 98 USPQ 277 (1953). Additionally, the structure similarity of the compound of invention in the copending application and the compound because similar compounds are generally expected to have similar properties and have similar utilities. In re Gyurik, 596 F.2d 1012, 201 USPQ 552 (CCPA 1979).

B. Provisional Obviousness-Type Double Patenting

Claims 1, 2, 5 and 6 are *provisionally* rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over:

(1) claims 1-3, 5, 6 of copending Application No. 10/785,839; and

(2) claims 1, 2, 6, 7, and 15 of copending Application No. 10/416,219.

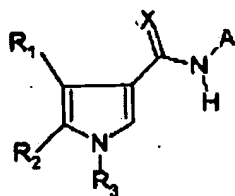
This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See In re Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); In re Van Ornum, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). See also M.P.E.P. § 804 (2001).

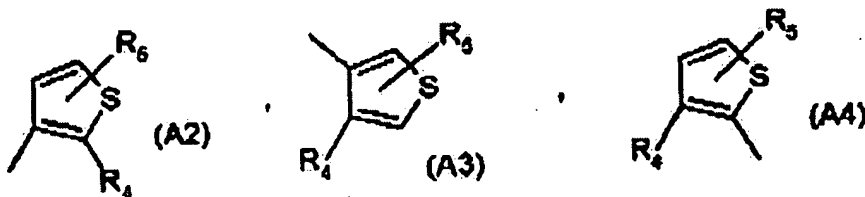
Obvious-type nonstatutory double patenting rejection is "analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. §103" with the distinction that the double patent rejection is not considered prior art. Id. See also In re Braithwaite, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Thus, the analysis employed in an obviousness-type double patent rejection is consistent with a §103(a) analysis set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966).

Although the conflicting claims are not identical, they are not patentably distinct from each other. First, **Instant Claims 1, 2, 5 and 6** are drawn to compounds of Formula (I),

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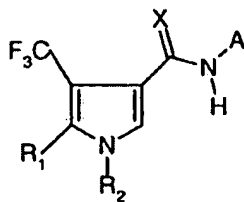
wherein A is a group selected from A₂, A₃ or A₄



wherein: X is oxygen, R_1 is substituted or unsubstituted C₁-C₄ alkyl, with the exception of CF₃; substituted or unsubstituted C₃-C₆ cycloalkyl; or halogen; R_2 is hydrogen, substituted or unsubstituted C₁-C₄ alkyl; substituted or unsubstituted C₁-C₄ alkoxy; cyano or halogen; R_3 is substituted or unsubstituted C₁-C₄ alkyl; R_4 *inter alia* represents C₃-C₇ cycloalkyl, C₄-C₇ cycloalkenyl; R_5 represents hydrogen, cyano, nitro, halogen, C₁-C₄ haloalkyl, C₁-C₄ alkyl, C₁-C₄ alkoxy-C₁-C₄ alkyl. (See Amend. to the Claims, pp. 2-5).

Determining the Scope and Contents of the Co-pending Application

1. Conflicting claims 1-3, 5 and 6 of copending Application No. 10/785,836 recite a compound of formula (I). (See Claim 1, p. 52).



R_1 is hydrogen, substituted or unsubstituted C₁-C₄ alkyl or halogen;

R_2 represents substituted or unsubstituted C₁-C₄ alkyl;

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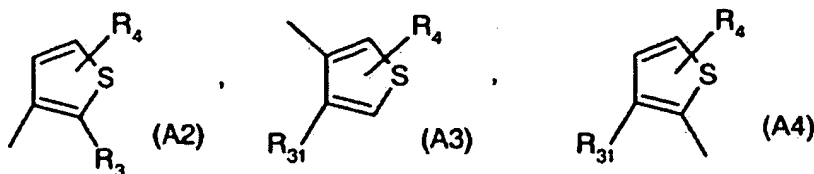
R₃ – R₅ represents

R₃ is C₃-C₇cycloalkyl unsubstituted or mono- to trisubstituted by halogen, hydroxy, C₁-C₄alkoxy, C₁-C₄haloalkyl, C₂-C₄alkenyl, C₂-C₄alkynyl, C₁-C₄haloalkoxy or C₁-C₄alkyl; C₄-C₇cycloalkenyl unsubstituted or mono- to trisubstituted by halogen, hydroxy, C₁-C₄alkoxy, C₁-C₄haloalkyl, C₂-C₄alkenyl, C₂-C₄alkynyl, C₁-C₄haloalkoxy or C₁-C₄alkyl; C₆-C₇cyclodialkenyl unsubstituted or mono- to trisubstituted by halogen, hydroxy, C₁-C₄alkoxy, C₁-C₄haloalkyl, C₂-C₄alkenyl, C₂-C₄alkynyl, C₁-C₄haloalkoxy or C₁-C₄alkyl; thienyl, furyl, pyrrolyl, pyrazolyl, oxazolyl, thiazolyl, isoxazolyl, isothiazolyl, thiadiazolyl, imidazolyl, triazinyl, benzothienyl, tetrazolyl, 5,6-dihydro-1,4,2-dioxazinyl, pyridyl, pyrazinyl, pyridazinyl or pyrimidinyl, which are unsubstituted or substituted by halogen, C₁-C₆haloalkyl, C₁-C₆alkyl, hydroxy, cyano, nitro, CHO, C₁-C₄alkoxy-C₁-C₄alkyl, COOC₁-C₄alkyl, C₁-C₆haloalkoxy-C₁-C₄alkyl, C₁-C₆alkoxy or C₁-C₆haloalkoxy;

R₃₁ is C₃-C₇cycloalkyl, C₃-C₇cycloalkenyl or C₅-C₇cycloalkadienyl which are unsubstituted or substituted by halogen, C₁-C₆alkoxy, C₁-C₆alkoxy-C₁-C₆alkyl, C₁-C₆haloalkoxy-C₁-C₄alkyl, C₁-C₄alkyl, C₁-C₄haloalkyl, C₁-C₄haloalkoxy, C₂-C₄alkenyl or C₂-C₅alkynyl; phenyl unsubstituted or substituted by halogen, C₁-C₆alkoxy, C₁-C₆haloalkoxy, C₁-C₄alkyl, C₁-C₄haloalkyl, C₂-C₄alkenyl, C₂-C₅alkynyl, CHO, COOC₁-C₄alkyl, C₁-C₄alkoxy-C₁-C₄alkyl, C₁-C₄alkyl-C₁-C₄alkoxy, C₁-C₄haloalkoxy-C₁-C₄alkyl, C₁-C₄haloalkyl-C₁-C₄alkoxy, cyano or nitro; thienyl, furyl, pyrrolyl, pyrazolyl, oxazolyl, thiazolyl, isoxazolyl, isothiazolyl, thiadiazolyl, imidazolyl, triazinyl, pyridyl, pyridazinyl, pyrazinyl or pyrimidinyl, which are unsubstituted or substituted by halogen, C₁-C₆haloalkyl, C₁-C₆alkyl, hydroxy, cyano, nitro, CHO, COOC₁-C₄alkyl, C₁-C₆haloalkoxy-C₁-C₄alkyl, C₁-C₄alkoxy-C₁-C₄alkyl, C₁-C₆alkoxy or C₁-C₆haloalkoxy;

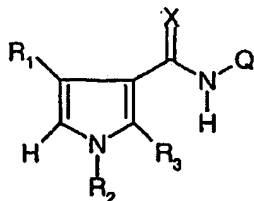
R₄ is hydrogen; cyano; nitro; halogen; C₁-C₄alkoxy; C₁-C₄haloalkyl; C₁-C₄alkyl; C₁-C₄alkoxy-C₁-C₄alkyl; C₅-C₇cycloalkyl unsubstituted or substituted by C₁-C₃alkyl or C₁-C₃haloalkyl; C₁-C₄haloalkoxy-C₁-C₄alkyl; or C₁-C₄haloalkoxy; and

R₅, R₆, R₇, R₈ and R₉ are identical or different and are each independently of the others hydrogen, halogen, C₁-C₄haloalkyl, C₁-C₄alkyl, C₁-C₆haloalkoxy-C₁-C₄alkyl, C₁-C₄alkoxy, C₁-C₄haloalkoxy, C₁-C₄alkoxy-C₁-C₄alkyl or C₃-C₇cycloalkyl.

X represents oxygen; and**A is A2, A3 and A4. (See Claim 1, p. 52).**

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2. Conflicting claims 1, 2, 6, 7, and 15 of copending Application No. 10/416,219 recite a compound, of Formula (I). (See Claim 1, p. 49).



R_1 is CF_2H or CFH_2 ;

R_2 represents C_1 - C_3 alkyl;

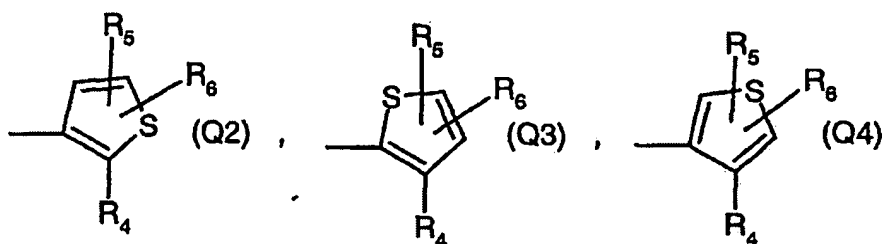
R_3 represents hydrogen;

R_4 is unsubstituted or substituted C_6 - C_{14} bicycloalkyl, bicycloalkenyl or C_6 - C_{14} bicycloalkadienyl;

R_5 and R_6 are independently of each other hydrogen or halogen;

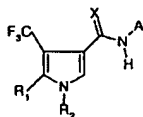
X represents oxygen; and

Q is Q_2 , Q_3 and Q_4 . (See Claim 1, p. 49).



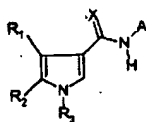
Ascertaining the Differences Between the Copending Application and the Instant Claims

The difference between the instant claims and copending application 10/785,836 is that the compound of formula (I) is drawn to a subgenus wherein the formula is drawn to trifluorocarbon pyrrolecarboxamide.

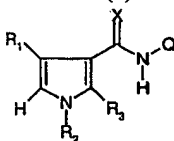


Contrarily, the Instant application is

drawn to pyrrolecarboxamide wherein the pyrrole may be substituted (R1) with substituted C₁-C₄ alkyl groups, except CF₃.

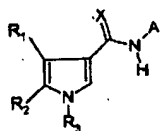


The difference between the instant claims and copending application 10/416219 is that the compound of formula (I) is drawn to a subgenus wherein the pyrrole is unsubstituted at the *ortho* position.



Also the substitutions of the thiophene rings (Q) can be

substituted with C₆ and C₇ bicycloalkyl, bicycloalkenyl and bicycloalkadienyl ring systems. (See Claim 1, p.49). The Instant invention however is drawn to a generic pyrrole ring



wherein R₂ represent hydrogen and the substitution on the thiophene ring (A) represents C₃-C₇ cycloalkyl, C₄-C₇ cycloalkenyl, or C₅-C₇ cycloalkadienyl.

Resolving the Level of Ordinary Skill in the Pertinent Art

Absent a showing of unexpected results, it would have been obvious to one of ordinary skill in the art to synthesize the compound of the conflicting claims in copending application 10/785836 and 10/416,219.

Regarding Application 10/785,836, a person skill in the pertinent art would be motivated to prepare the compounds of the instant invention by replacing the CF₃ for other halo substituted alkyls such as CBr₃, CCl₃ or CI₃ because fluorine, chloring, bromine and iodine are all halogens and all classified in Group VII of the periodic table and therefore have similar properties. See e.g. Ex parte Wiseman, 98 USPQ 277 (1953). Additionally, the structure similarity of the compound of invention in the copending application and the compound because similar compounds are generally expected to have similar properties and have similar utilities. In re Gyurik, 596 F.2d 1012, 201 USPQ 552 (CCPA 1979).

Regarding Application 10/416,219, a person skill in the pertinent art would be motivated to prepare the compounds of the instant invention because the cycloalkyl, cycloalkenyl and cycloalkadienyl as recited in the instant application encompasses mono and polycyclic systems.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application that matured into a patent. *See In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). *See also* MPEP § 804.

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

VI. OBJECTIONS

Claim Objection-Non Elected Subject Matter

Claim 1 is objected to as containing non-elected subject matter. To overcome this objection, Applicant should amend Claim 1 by deleting/canceling “or pyrrolothioamide” in line 1 of claim 1 and deleting/canceling “orthosubstituted aryl” in line 10 where Applicant defines “A;” and by deleting “heteroaryl” and inserting “thiophenes” in line 10 where Applicant defines “A.” directed solely to the subject matter indicated as being examinable, supra.

Claim Objections

Claims 2 and 6 are objected to because of the following informalities: The claims contain semicolon followed by a period. The semicolon should be deleted. Appropriate correction is required.

Dependent Claim Objections

Dependent Claims 2, 5 and 6 are also objected to as being dependent upon a rejected based claim. To overcome this objection, Applicant should rewrite said claims in an independent form and include the limitations of the base claim and any intervening claim.

VII. CONCLUSION

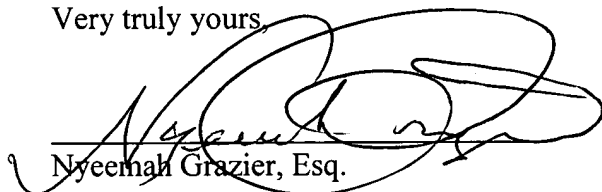
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nyeemah Grazier whose telephone number is (571) 272-8781. The examiner can normally be reached on Monday through Friday from 8:30 a.m. - 5:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (571) 272 - 0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

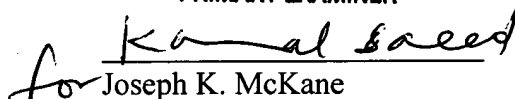
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Very truly yours,



Nyeemah Grazier, Esq.

KAMAL A. SAEED, PH.D.
PRIMARY EXAMINER



for Joseph K. McKane
Supervisory Primary Examiner, AU 1626

Patent Examiner, AU 1626
UNITED STATES PATENT AND TRADEMARK OFFICE
400 Dulany Street
Remsen Building, 5B29
Alexandria, VA 22314-5774
Tel.: (571) 272-8781